

- (1) claim 1
- (2) claims 3-5
- (3) claim 6
- (4) claims 7-9
- (5) claim 10
- (6) claim 9
- (7) claim 11
- (8) claim 12
- (9) claim 13
- (10) claim 14
- (11) claim 16
- (12) claim 17

Turning now to the specifics, it is submitted that in formulating the rejection, an inconsistent view has been taken with respect to the subject matter of claim 1. On page two of the Action, it was asserted that the Smith et al publication teaches printing control information which involves "the kind of ink most suitable for the ink jet recording medium." However, on page five of the Action, it was acknowledged that the Smith et al publication differs in this regard, but it the was asserted that one of ordinary skill in the art would readily devise such an alternative or modification.

It is submitted that, with reference to the rejection of claim 1, this rejection is not appropriate. Among other thing, it is submitted that one of ordinary skill the art would not be led to modify the cited Smith et al publication to achieve the presently claimed invention. In particular, it must be emphasized in support of the patentability of the subject invention over the publication is that there is no suggestion to motivate one of ordinary skill in the art to modify the known art in the manner proposed by the examiner. It is well established principle of U.S. patent practice that the prior art must contain some suggestion for modification since without such, any modification is pure speculation on the part of the examiner and is based on a prohibited hindsight reconstruction from applicants' own disclosure.

Furthermore, it is submitted that at least some of the dependent claims define subject matter not taught or suggested by the cited Smith et al publication. Specifically, the comments concerning these claims are as follows:

(2) claims 3-5 - There does not appear to be any disclosure in the Smith et al publication relative to steps taken when no printing control information is detected.

(3) claim 6 - No teaching in the Smith et al publication could be discerned as to comparing stored information with detected information.

(4) claims 7-9 - The distinction in (3) appears to be applicable as well as the publication failing to teach the steps taken when the information does not agree.

(7) claim 11 - No disclosure relative to stopping ink discharge and then using a roll-recovering apparatus is contained in the cited Smith et al publication.

(8) claim 12 - Again, no disclosure in the Smith et al publication could be discerned relative to stopping ink discharge and then using a roll-recovering apparatus.

(9) claim 13 - There is no teaching in the Smith et al publication of using a roll-recovering apparatus.

(10) claim 14 - There does not seem to be any disclosure using a tray apparatus.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 1, 3-14 and 16-17 over the cited patents are respectfully requested.

Applicants acknowledge with appreciation the indication that claims 15 and 18-19 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims.